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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,019	01/11/2002	Jean-Francois Courtoy	78200-040	5197

7590 09/29/2004

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EXAMINER	
VO, HAI	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/046,019	COURTOY ET AL.	
	Examiner	Art Unit	
	Hai Vo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-58* is/are pending in the application.

4a) Of the above claim(s) *1-30 and 37-45* is/are withdrawn from consideration.

5)☒ Claim(s) *31,32, 34-36,46,48,49,53 and 55* is/are allowed.

6)☒ Claim(s) *33,47,50,52,54,56 and 58* is/are rejected.

7)☒ Claim(s) *51 and 57* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. All of the art rejections are withdrawn in view of the present amendment and arguments. However, upon further consideration, a new ground(s) of rejection is made in view of Courtoy et al (Re 33, 599) in view of Chen et al (US 6,555,216).
2. Claims 33, 47, 50, 52, 54, 56 and 58 are allowed.
3. Claims 51 and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 31, 32, 34-36, 46, 48, 49, 53 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Courtoy et al (Re 33, 599) in view of Chen et al (US 6,555,216). It is noted that the second ink and the third ink are not required by the claims and therefore any limitations associated with them are completely excluded from the claims. Courtoy teaches a synthetic covering comprising a substrate, a foamed plastic layer overlaying the substrate, a first ink 3 containing an expansion inhibitor and an UV initiator on the foam layer (column 7, lines 13-15). Courtoy further discloses that the synthetic covering comprises an additional ink 4 containing the UV initiator on the foam layer (column 7, lines18-20). Courtoy teaches a cured layer overlaying the foam layer and first ink wherein the portion of the cured layer

disposed over the first ink 3 is mechanically embossed with a graining roll. Courtoy teaches that the cured layer is subjected to a sufficient temperature for a sufficient time in order to soften the wear layer to allow it to be grained. Courtoy does not specifically disclose the mechanically embossed texture having relatively deep embossed depths as compared with a matting grain. Chen teaches a surface covering having a substrate, a foam layer, a design layer formed with a retarder ink and a wear layer having a wood, stone, marble, granite or brick surface texture (abstract, column 14, lines 43-53). Chen discloses that the wear layer is subjected to a sufficient temperature for a sufficient time in order to soften the wear layer to allow it to be mechanically embossed. It is noted that none of the processing steps disclosed in the Chen invention is relied on for the art rejections. In view of Chen's teaching, one of skilled in the art would use the textured roll to mechanically emboss different textures onto the cured layer of the Courtoy invention to provide the surface covering having a pattern that simulates the surface texture of wood, stone, granite or brick. Therefore, it would have been obvious to one having ordinary skill at the time the invention was made to substitute the textured roll with the graining roll for purposes of mechanical embossing motivated by desire to provide the surface covering with a texture finish.

Courtoy discloses the graining portion of the cured layer that is not disposed over the ink containing a photoinitiator is smoothed over (column 7, lines 55-61). Likewise, it is clearly apparent that the combination of Courtoy and Chen would arrive at the surface covering of the presently claimed invention which has the

mechanically embossed portion of the cured layer that is not disposed over the first ink is smoothed over.

Courtoy does not specifically disclose a polyurethane coating overlaying the cured coating. Chen teaches a surface covering comprising a urethane top coat overlaying the wear layer to provide the covering surface more resistance to changes under future conditions (figure 11, column 16, line 1). Thus, it would have been obvious to one having ordinary skill at the time the invention was made to apply a polyurethane coating onto the cured coating of Courtoy motivated by desire to provide the surface covering more resistance to changes under future conditions.

6. Claims 31, 34-36, 46, 48, 49, 53, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al (US 6,555,216) in view of Courtoy et al (Re 33, 599) substantially as set forth in the 04/23/2004. The art rejections have been repeated for the following reasons. Applicants argue that there is no mechanical embossing on portions of the product which do not overlie the first printing ink and this distinguishes Chen. The examiner disagrees. Figures 10 and 11 of Chen show that Chen does not mechanically emboss the chemically embossed areas or the grouted lines. The art rejections are accordingly sustained.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 31, 32, 34-36, 46, 48, 49, 53 and 55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. Re 33,599 in view of Chen et al (US 6,555,216). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons as set forth in the paragraph no. 4, which are believed to be pertinent.

Allowable Subject Matter

9. Claims 33, 47, 50, 52, 54, 56 and 58 are allowed.

10. Claims 51 and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art taken alone or in combination teaches or suggests the surface covering as defined in the claims wherein the portion of the cured coating which is not disposed over the ink is mechanically embossed with a second mechanically embossed texture different from the first mechanically embossed texture. It is noted that the second mechanically embossed texture has relatively deep emboss depths such as natural looking texture of stone, wood, etc... as described at page 16 of Applicant's specification.

Response to Arguments

11. The art rejections over Courtoy et al (Re 33, 599) in view of Baskin (US 4,877,656) have been overcome by the present amendment and response. As pointed out by Applicants at page 17 of the 07/21/2004 amendment, the combination of Courtoy and Baskin cannot produce the product of Applicants' claims. The curable synthetic resin composition of Baskin becomes hardened during the curing (column 4, lines 1-30). The deep embossing created by Baskin's method would not smooth over on selected areas during gelling as described by Courtoy.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

TERREL MORRIS
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